

11/29/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Eastern National

Serial No. 75/503,342

Robert E. Rosenthal for Eastern National.

Amy B. Hella, Trademark Examining Attorney, Law Office
110 (Chris A. F. Pedersen, Managing Attorney).

Before Hanak, Hohein and Chapman, Administrative
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge.

On June 16, 1998 Eastern National (applicant) filed an intent-to-use application seeking to register INDEPENDENCE PARK INSTITUTE in typed drawing form for publications; clothing; retail store and gift shop services; educational and entertainment services; promotional campaigns and services; and computer services. In point of fact, applicant's recitation of goods and services was very detailed in that it specified the exact nature of applicant's publications, clothing and the like. However, because the precise nature of applicant's goods and services is not an issue in this

proceeding, they will not be recited here.

In the first Office Action, the Examining Attorney
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suggested slight modifications to the identification of goods and services, which applicant agreed to. In addition, the Examining Attorney stated that "applicant must insert a disclaimer of PARK INSTITUTE in the application." The Examining Attorney provided no explanation as to why such a disclaimer was required. In response, applicant offered to disclaim simply the word INSTITUTE, and this disclaimer was accepted by the Examining Attorney.

In the second Office Action, the Examining Attorney argued for the first time that applicant's mark INDEPENDENCE PARK INSTITUTE was "primarily geographically descriptive of applicant's goods and services," and thus was not entitled to registration on the Principal Register. The Examining Attorney cited Section 2(e)(2) of the Trademark Act.

When the refusal to register pursuant to Section 2(e)(2) was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

The facts in this case are not in serious dispute. With her second Office Action, the Examining Attorney attached an excerpt from Merriam Webster's Geographical

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Dictionary (3rd ed. 1997) showing that there exists in Philadelphia a park known as Independence National Historical Park. This dictionary does not indicate that this park is also known as Independence Park. Applicant does not dispute the fact that it is located in the greater Philadelphia area, and that it proposes to provide its goods and services in that area.

The Examining Attorney conducted two NEXIS searches for stories incorporating the term Independence Park and either the term Independence Hall or the term Pennsylvania. The Examining Attorney then made of record thirteen stories wherein the term Independence Park is used to refer to a particular park in Philadelphia. The Examining Attorney argues that, while the official name of the park is Independence National Historical Park, on occasion this park is referred to simply as Independence Park. Applicant is in agreement that the official name

of the park is Independence National Historical Park, and that on a few occasions this park is referred to as Independence Park.

Applicant conducted its own NEXIS search for just the term Independence Park. In so doing, applicant received the following message from NEXIS: "Your search has been

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interrupted because it probably will retrieve more than 1,000 documents." NEXIS then afforded applicant the opportunity to "retrieve the top 50 documents," which applicant did. Applicant then made of record 15 of these top 50 documents (stories). These stories reveal that there are numerous parks named Independence Park and that these parks exist in at least nine additional states, namely, California, Georgia, Indiana, Kansas, Louisiana, Massachusetts, North Carolina, Rhode Island and Wisconsin. Applicant argues that even if one assumes for the sake of argument that Independence National Historical Park in Philadelphia is generally known to the American public, the record fails to demonstrate that this park's "nickname" (Independence Park) is generally

known to the American public.

In determining whether a term is "primarily geographically descriptive" pursuant to Section 2(e)(2) of the Trademark Act, "the word 'primarily' should not be overlooked, for it is not the intent of the federal statute to refuse registration of a mark where the geographic meaning is minor, obscure [or] remote." 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 14:28

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at page 14-44 (4th ed. 2001). For example, our primary reviewing Court reversed this Board's refusal to register VITTEL for soaps, lotions and toiletries despite the fact that there was a town in France by that name which was renowned for its health spa and mineral water. In re Societe Generale des Eaux Minerales de Vittel S.A., 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987). In so doing, the Court noted that the PTO had simply failed to prove that Vittel, France was "generally known" to American consumers. 3 USPQ2d at 1452.

Based upon the record before us, we find that only a minor number of Americans -- upon hearing the term

Independence Park -- would associate this term with a specific park in Philadelphia. As previously noted, after the Examining Attorney conducted NEXIS searches for Independence Park in conjunction with either Pennsylvania or Independence Hall, she put in the record but a mere thirteen stories. In contrast, when applicant conducted a NEXIS search on Independence Hall per se, applicant was warned that its search would turn up over 1,000 stories. Applicant then reviewed the first 50 of these stories, and found that just these stories alone demonstrated that these were

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Independence Parks in at least nine additional states. Had applicant been able to physically review the over 1,000 NEXIS stories, they may well have demonstrated that there exist Independence Parks in numerous other states. To state the obvious, the term Independence Park is not particularly distinctive. It falls in the same category as such terms as Memorial Park and Veterans Park. In short, based on this record, we find that there is no one Independence Park whose geographic significance is any

more than minor.

Decision: The refusal to register is reversed.

